

## REMARKS

Claims 1-3 have been withdrawn by Applicant after consideration of Examiner's comments under 35 USC 103.

Claim 4 was amended and Claims 5-10 were withdrawn after consideration of Examiner's comments under 35 USC 102.

### 35 U.S.C. § 102

The examiner has rejected claims 4-7 and 9-10 as being anticipated by Widjaja (U.S. 5,599,274).

For a 35 U.S.C. § 102 rejection, it is well established case law that "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Examiner is correct to contend that Applicant's device contains many of the elements of the device in Widjaja. However, unlike the device in Widjaja, Applicant's device has been specifically designed to be portable. This presents a significant advantage and a novel improvement over the prior art. A user will be able to utilize Applicant's device without being connected to a power source. This will allow users to gain the benefit of the relaxation device at various locations such as in the woods and on the beach. In addition, Applicant's device is smaller

and can be easily packed and carried for those traveling. These apparent advantages in Applicant's device represent elements that are not present in the device of Widjaja. Claim 4 has been amended to reflect these differences. Accordingly, claims 5-8 have been withdrawn. Similarly, Applicant has chosen to withdraw claims 9-10 from consideration. Consequently, Examiner is respectfully requested to reconsider the rejection of claims 4-under 35 U.S.C. § 102 in light of these amendments and the foregoing comments.

### **35 U.S.C. § 103**

#### **Claims 8 was rejected over Widjaja in view of Koyama**

Examiner had rejected Claim 8 under 35 U.S.C.103 as being unpatentable over Widjaja et al. in view of Koyama et al. (US 6,053,936).

In order to establish a *prima facie* case of obviousness under 35 U.S.C. § 103, the examiner must demonstrate that there is a suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine the reference teachings. Furthermore, the prior art references must teach or suggest all of the claimed features. It is well settled law that the prior art itself must provide the motivation for a proposed alteration of a reference. Ex parte Chicago Rawhide Manufacturing Co., 220 U.S.P.Q. 351, (B.O.P.A. 1984). Moreover, the suggestion must be plain and clear or the rejection is untenable. Fromson v. Offset Plate, Inc., 225 U.S.P.Q. 26, 32 (Fed. Cir. 1985); Kimberly-Clark Corp. v. Johnson & Johnson, 223 U.S.P.Q. 603, 610 (Fed. Cir. 1984). The Examiner is

not free to pick bits and pieces from the prior art and, with the hindsight benefit of applicants' disclosure, attempt to reconstruct the invention. Orthopedic Equipment, Inc. v. U.S., 217 U.S.P.Q. 193, 199, (Fed. Cir. 1983).

An invention is often the product of devices that preceded it. It is truly a rare invention that does not incorporate any existing technology in its components. If all of the elements of applicant's invention were disclosed by two references, and only a minor borrowing of elements between the two references is necessary to achieve applicant's invention, then this would be a strong case of obviousness. In rejecting claim 8 however, Examiner has combined diverse elements of two light emitting devices which differ significantly from applicant's invention. As stated earlier, Examiner is not free to pick bits and pieces from the prior art and, with the hindsight benefit of the applicant's disclosure, attempt to reconstruct the invention. Orthopedic Equipment, Inc. v. U.S., 217 U.S.P.Q. 193, 199, (Fed. Cir. 1983). Yet, in combining these two references to form the present invention, this is precisely what Examiner is doing. The present invention is a significant departure from the references cited by the Examiner.

Examiner is respectfully requested to reconsider the rejection of claim 8 under 35 U.S.C. § 103 in light of the amendments to the claims and the foregoing comments.

## **CONCLUSION**

In view of the foregoing amendment and remarks, it is believed that this Application is now in condition for allowance. Early and favorable reconsideration is respectfully solicited.

If the Examiner has any questions regarding the foregoing amendment and remarks, or if prosecution of this Application could be furthered by a telephone interview, the Examiner is requested to telephone the Applicant's undersigned attorney.

Respectfully submitted,

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